

REMARKS

In the Office Action mailed September 22, 2008 (the "Office Action"), the Examiner rejected claims 15-18 under 35 U.S.C. § 112, second paragraph; rejected claims 15-19 under 35 U.S.C. § 101; and rejected claims 15-19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,463,421 to Junger ("*Junger*") in view of U.S. Patent No. 6,536,659 to *Hauser et al.* ("*Hauser*").

By this Amendment, Applicants cancel claims 1-14 and 20-23 without prejudice or disclaimer, amend claims 15-19, and add new claims 24-33.

I. The Rejection of Claims 15-18 under 35 U.S.C. § 112, second paragraph

The Office action alleges a number of recitations of claim 15 do not have sufficient antecedent basis (Office Action at p. 2). In light of the amendments presented herein, Applicants submit that claim 15 provides sufficient antecedent basis for each recitation. Claims 16-18 were apparently rejected solely due to their dependence from independent claim 15. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 15-18 under 35 U.S.C. § 112, second paragraph.

II. The Rejection of Claims 15-19 under 35 U.S.C. § 101

The Office Action alleges that claim 15 does not recite statutory subject matter because the claim is not "tied to another statutory class" (Office Action at pp. 2-3). Amended claim 15 includes recitations such as "storing, in a memory device, data" As a "memory device" falls at least under the statutory class of "article of manufacture," amended claim 15 recites statutory subject matter. Moreover, the Office Action

concedes that positively reciting another statutory class in this manner is sufficient to render the claimed subject matter statutory (Office Action at p. 3).

For at least the reasons discussed above, claim 15 recites statutory subject matter. Claims 16-19 were apparently rejected solely due to their dependence from independent claim 15. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 15-19 under 35 U.S.C. § 101.

III. The Rejection of Claims 15-19 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 15-19 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

Claim 15, for example, recites a method for remanufacturing cores into remanufactured items, comprising the steps of "providing a total price for the remanufactured items, the total price including at least a refundable core deposit and a remanufactured item price, the core deposit being paid with the total price to secure return of cores for remanufacture" (emphasis added).

Junger discloses a method and apparatus for efficient handling of product returns using a computer system to scan returned products for identifying information (*Junger*, abstract). *Junger* also discloses using a printer to print labels to place on packaging for the returned products, such as by placing the labels on a pallet (*Junger*, col. 8, lines 53-65). The Office Action relies on *Junger's* pallets or other packaging as allegedly corresponding to the claimed "core" (See Office Action at pp. 3-4, citing *Junger*, col. 8, lines 53-65).

However, *Junger's* pallets or other packaging are simply packaging for sold products, and are not "cores" used for "remanufacture." Further, even assuming *Junger's* pallets or other packaging could reasonably be characterized as "cores," *Junger* does not disclose that the customer pays an refundable deposit for the pallet or other packaging. Therefore, *Junger* does not teach or suggest "providing a total price for the remanufactured items, the total price including at least a refundable core deposit and a remanufactured item price, the core deposit being paid with the total price to secure return of cores for remanufacture," as recited by independent claim 15 (emphasis added).

Hauser fails to cure the deficiencies of *Junger*. *Hauser* discloses a method for handling goods returned by customers of a plurality of different merchants (*Hauser*, abstract). Customers are provided a return authorization shipping label by a central return facility, and then ship the merchandise to the central return facility (*Hauser*, abstract). *Hauser* also discloses that certain returned goods will be repackaged or refurbished (*Hauser*, col. 5, lines 58-65). The Office Action relies on *Hauser's* refurbished goods as allegedly corresponding to the claimed "cores" (See Office Action at p. 4, citing *Hauser*, col. 5, lines 58-65).

However, while *Hauser* discloses that some goods may require refurbishing, *Hauser* does not disclose any "core deposit" that paid as part of a total purchase price for such goods. Instead, *Hauser's* customers are refunded for the price of the returned merchandise (See *Hauser*, col. 5, lines 21-23). Further, the claimed "core deposit" is paid to "secure return of cores for remanufacture." *Hauser* does not suggest that the

customers pay a deposit to secure the return of products for refurbishing. Therefore, *Hauser* does not teach or suggest "providing a total price for the remanufactured items, the total price including at least a refundable core deposit and a remanufactured item price, the core deposit being paid with the total price to secure return of cores for remanufacture," as recited by independent claim 15 (emphasis added).

Claim 15 also recites "updating the data stored on the memory device by applying the credit for the core associated with the sale of the later-sold remanufactured item against the earlier core liability, irrespective of the core deposit for the later-sold remanufactured item having been paid after the sale of the earlier-sold remanufactured item" (emphasis added). *Junger* and *Hauser* also fail to teach or suggest these recitations of independent claim 15.

As discussed, *Junger* fails to teach or suggest a "core deposit" component of a total price for a remanufactured item. *Junger* merely discloses handling of product returns using a printer to print labels to place on packaging for the returned products, such as by placing the labels on a pallet, and using a computer system to scan the returned products for identifying information (*Junger*, abstract and col. 8, lines 53-65). *Junger* does not, however, disclose any liability associated with the sale of a remanufactured item. Therefore, *Junger* also fails to teach or suggest "updating the data stored on the memory device by applying the credit for the core associated with the sale of the later-sold remanufactured item against the earlier core liability, irrespective of the core deposit for the later-sold remanufactured item having been paid after the sale of the earlier-sold remanufactured item," as recited by independent claim 15.

As discussed, *Hauser* discloses a method for handling goods returned by customers of a plurality of different merchants, and that certain returned goods will be refurbished (*Hauser*, abstract and col. 5, lines 58-65). *Hauser* also discloses that when a container with returned goods is received, the contents are matched against the merchandise expected to be in the container (*Hauser*, col. 5, lines 5-35). *Hauser* matches the returned merchandise using a bar code that indicates what merchandise is in the return (*Hauser*, col. 4, line 35 to col. 5, line 5).

Thus, to the extent that *Hauser* matches any "liability" at all, *Hauser* simply matches the returned merchandise to the corresponding bar code. *Hauser* does not disclose or suggest applying credit for the returned merchandise to liabilities based on when the liabilities are incurred. At best, any liabilities in *Hauser* would be matched directly to the corresponding purchase of the merchandise. However, *Hauser* does not disclose applying credit for the sale of a later sold item against a liability incurred for an earlier sold item. Therefore, *Hauser* also fails to teach or suggest "updating the data stored on the memory device by applying the credit for the core associated with the sale of the later-sold remanufactured item against the earlier core liability, irrespective of the core deposit for the later-sold remanufactured item having been paid after the sale of the earlier-sold remanufactured item," as recited by independent claim 15.

In view of the above, *Junger* and *Hauser*, alone or in combination, do not disclose or suggest at least these recitations of independent claim 15. Therefore, amended claim 15 is allowable over *Junger* and *Hauser*. Claims 16-19 are dependent

from claim 15, and are therefore allowable over *Junger* and *Hauser*, at least for the same reasons that claim 15 is allowable over these references.

IV. New Claims 24-33

Claims 24 and 29 are independent claims. Claims 25-28 depend from independent claim 24, and claims 30-33 depend from independent claim 29. Independent claims 24 and 29 are allowable over *Junger* and *Hauser* for reasons similar to those discussed above regarding independent claim 15. Dependent claims 25-28 and 30-33 are allowable over *Junger* and *Hauser* at least due to their dependency.

V. Conclusion

In view of the above remarks, Applicants respectfully submit that the claims are allowable over the cited prior art. Accordingly, Applicants respectfully request reconsideration and re-examination of this application and the timely allowance of all pending claims.

Applicants respectfully request that the Examiner contact the undersigned, Philip J. Hoffmann, if the Examiner considers that the present response does not overcome the prior art of record. The undersigned can be reached at (202) 408-4398.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 17, 2008

By: 

Philip J. Hoffmann
Reg. No. 46,340